UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/729,815	12/06/2000	Daniel Newman	2717.100	9252

5514   7590   05/17/2005

FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER
HEWITT II, CALVIN L

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>04 March 2005</u>.

2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
  closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-59,61 and 63-71* is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-59,61 and 63-71* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

Status of Claims

1.   Claims 1-59, 61 and 63-71 have been examined.

Response to Amendments

2.   Applicant has amended the claims to include language Applicant believes

will overcome the teachings of the prior art. Specifically, the claims now recite a

user establishing one (or two) user-defined parameters and then selecting

content independent of said parameters. However, these features are clearly

taught by Dedrick. Dedrick teaches a user creating a search for an item (or

plurality of items) that includes the price, manufacturer, color, etc. of the item (or

for each item- i.e. item A price, item B price) (column 8, lines 18-53-66) and only

selecting the item that meets a portion of said criteria (column 9, lines 1-9).

Hence, Dedrick teaches a user selecting content independent of user-defined

parameters. Regarding claim 33, Examiner has applied a rejection under section

112. Specifically, claim 33 contains conflicting limitations as the system provides

for content to be selected independent of user defined fee data and also checks

the same fee data to determine whether said content is pre-approved regarding

fee data. Therefore, as Dedrick teaches user purchases using a credit card

(column 7, lines 19-28) and credit card purchases require additional authorization.

Applicant's claims contain "intended use" language (i.e. "adapted to") however, a recitation directed to the manner in which a claimed apparatus is intended to be used does not distinguish the claimed apparatus from the prior art- if the prior art has the capability to so perform (MPEP 2114, Ex parte Masham, 2 USPQ2d 1647 (1987)).

The Examiner would like to again point out the subject matter of pages 40 and 41 in Applicant's specification that distinguishes Applicant's system from the prior art of Dedrick.

The following assertion of facts have gone unchallanged and are considered admitted prior art:

- messages to users indicating "insufficient funds" or "overdrawn" are old and well known

Claim Rejections - 35 USC § 112

3.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4.   Claims 33-57 are rejected under 35 U.S.C. 112, second paragraph, as

being indefinite for failing to particularly point out and distinctly claim the subject

matter which applicant regards as the invention.

Claim 33 is unclear to one of ordinary skill. Claim 33 recites determining

"... *whether the content has been pre-approved by the user-defined settings*, and

if the content has been pre-approved it is accepted without further authorization

by the user". However, claim 33 also recites retrieving "... content to the user

from the remote location in response to the content being selected by the user

wherein the content is selected *independently of the user defined settings*."

Therefore, as the user selected content independent of user defined fee data, it

[the content] will never be pre-approved and will always require additional

authorization ("... An essential purpose of patent examination is to fashion claims

that are precise, clear, correct, and unambiguous", *In re Zletz*, 893 F.2d 319,

321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Claims 34-57 are also rejected as they depend from claim 33.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set
forth in section 102 of this title, if the differences between the subject matter sought to be patented and
the prior art are such that the subject matter as a whole would have been obvious at the time the
invention was made to a person having ordinary skill in the art to which said subject matter pertains.
Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-9, 11, 13, 14, 16-23, 25, 27-37, 39, 40, 42-53, 55-57, and 63-71

are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick, U.S.

Patent No. 6,151,600.

As per claims 1-9, 11, 13, 14, 16-23, 25, 27-37, 39, 40, 42-53, 55-57, and

63-71, Dedrick teaches a method for enabling a user to obtain fee-based content

over a network comprising:

- setting user defined parameters to accept all fees below a

  predetermined amount and storing said settings on a memory

  medium (abstract; column/line 7/60-9/8; column/line 9/59-10/33;

  column 14, lines 58-67)

- displaying a first portion of content, from a content provider, at a

  user location (figure 2; column/line 9/58-10/3; column 10, lines 24-

  33)

- determining whether a second or additional portion of content

  requires payment of a fee by the user and displaying the second

  portion of content to the user when the fee for the second portion of

  content is accepted

  based on the user defined parameters (column/line 8/53-9/8;

  column/line 9/58-10/3; column 10, lines 23-33; column 11, lines 7-

  47; column 15, lines 1-21)

- accumulating a plurality of fees incurred by the user at a third party

  provider location, wherein the third party provider (e.g. internet

service provider, financial institution or credit card company) pays

the content provider the amount of the fees incurred by the user

and the user makes a payment to the third party provider on a

periodic basis and the user in turn pays the third party provider

(column 7, lines 19-29; column 11, lines 7-48; column 13, lines 15-

22; column 14, lines 15-32; column 15, lines 1-21)

- verifying the fees by the third party making payments to third party

   providers on a periodic basis (column 5, lines 38-43; column 7,

   lines 23-28; column 12, lines 32-40; column 14, lines 15-32)

- integrating the user-defined settings on a browser application

   (figure 2; column 2, lines 50-52; column 3, lines 23-60)

- accepting fees without prompting a user (column 8, lines 60-63)

- collecting content from a plurality of content providers utilizing

   HTML or other tags of each content provider website (figure 1)

- inputting a user-defined password prior to requesting content

   (column 3, lines 22-25; column 6, lines 1-6)

- generating an invoice as a function of fees incurred by a user

   (column 14, lines 15-32)

The Dedrick system enables a user to program an agent or search to retrieve

specific content information based on a user profile or a specific query (e.g.

price) (column 3, lines 22-60; column 7, lines 60-65; column 8, lines 18-25;

column 10, lines 18-22). For example, the system allows a user to conduct a search for items or content such as "cellphones for under 50 dollars". Dedrick also teaches a user-programmed agent that returns an item or content to a user, when the item or content doesn't meet the exact criteria. Specifically, a user is able to provide the agent with multiple criteria and the agent returning item or content information that meets only portion of said criteria (column 9, lines 1-9; column/line 9/59-10/3). Hence, a user may specify a "price", "date", "subject matter", and "content provider", and receive a search that only satisfies "subject matter" (e.g. cellphone for 60 dollars). Regarding the type of terminal used, it has been held that in order to be given weight in a method claim, the recited structure must affect the method in a manipulative sense (Ex parte Pfeiffer, 1962 C.D. 408 (1961)).

As per claims 63-65. Dedrick teaches a fee-based electronic information (e.g. content, items or services) over an electronic network that allows a user to specify parameters with which to retrieve said information (abstract; figure 2; column/line 8/18-9/8; column 10, lines 24-33). Dedrick teaches pre-authorizing said parameters through a user profile and overriding said parameters by allowing the system to retrieve electronic information wherein the information does not satisfy all the criteria (abstract; column 5, lines 32-53; column/line 6/36-7/18; column/line 8/60-9/8).

MPEP 2106, II, C states,

Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Therefore, these claims are broad as they are silent regarding what will be done if the content is not pre-authorized hence giving the claims their broadest reasonable interpretation, a reasonable alternative is at least to perform the processing of Dedrick where the user defines criteria such that the system returns electronic information that meets only a portion of the criteria (column/line 8/60-9/8; column/line 9/59-10/3). This rationale also applies to claims 5, 33 and 66.

7.   Claims 10, 12, 15, 24, 26, 38, 41 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick, U.S. Patent No. 6,151,600 in view of Fleming, U.S. Patent No. 5,953,710.

As per claims, 10, 12, 15, 24, 26, 38, 41 and 54, Dedrick teaches an end-user constructing a user profile and using said profile to determine the search, retrieval, access and payment of content (column 3, lines 22-60; column 7, lines 60-65; column 8, lines 18-25; column 10, lines 18-22). However, Dedrick does not specifically recite controls on the quantity of fees. Fleming teaches a system for controlling a user's access to fee-based content based on the total or quantity of transactions (abstract; column 6, lines 59-67; column 12, lines 5-26). Fleming also teaches controlling a user's access on a periodic basis (column 14, lines 55-

58) or renewal basis (column 12, lines 14-22). Hence, in light of the teachings of Fleming, it would have been obvious to one of ordinary skill to control a user's spending by limiting the user fixed amount of purchases on a weekly, monthly or yearly basis. Regarding messaging when fees exceed an accumulated amount, the Fleming teaching is dedicated to purchases made via credit or debit card (abstract), hence, the Examiner takes Official Notice that messages to users indicating "insufficient funds" or "overdrawn" are old and well known. Fleming also teaches a user terminal interacting with a third party terminal (figures 6 and 8-11). Regarding the type of terminal used, it has been held that in order to be given weight in a method claim, the recited structure must affect the method in a manipulative sense (Ex parte Pfeiffer, 1962 C.D. 408 (1961)). Therefore, it would have been obvious to one of ordinary skill to allow users of the Dedrick system to store the "child" or supervised credit cards of Fleming in the user's profile ('600, column 5, lines 33-43) in order to monitor a child's spending and/or protect against fraud ('710, column 3, lines 10-32).

8.   Claims 58-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dedrick, U.S. Patent No. 6,151,600 in view of Berstis et al., U.S. Patent No. 6,282,653.

As per claims 58-62, Dedrick teaches a system for allowing users to access fee-based content (abstract; figure 2; column 10, lines 24-33; column 14,

lines 15-32; column 15, lines 1-21). However, Dedrick does not specifically recite royalty payments to content providers. Berstis et al. teach a method and system for accumulating fees, accepting said fees from a user for accessing content and disseminating royalty payments based on said fee (column 8, lines 9-35; column 9, lines 45-53). Therefore, it would have been obvious to one of ordinary skill to combine the teachings of Dedrick and Berstis et al. in order to facilitate the efficient compensation of copyright holders for the use of their IP ('653, column 1, 30-67).

Conclusion

9.   The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Nakamura et al. teach electronic purse software stored on a smart card that only requires a PIN when a purchase exceeds a pre-set limit

- Chen et al. teach an electronic purse for storing credit card numbers wherein credit card transactions are authenticated using a PIN

10.   Any inquiry concerning this communication or earlier communications from

the Examiner should be directed to Calvin Loyd Hewitt II whose telephone

number is (571) 272-6709. The Examiner can normally be reached on Monday-

Friday from 8:30 AM-5:00 PM.

        If attempts to reach the Examiner by telephone are unsuccessful, the

Examiner's supervisor, James P. Trammell, can be reached at (571) 272-6712.

        Any response to this action should be mailed to:

        Commissioner of Patents and Trademarks

        c/o Technology Center 2100

        Washington, D.C. 20231
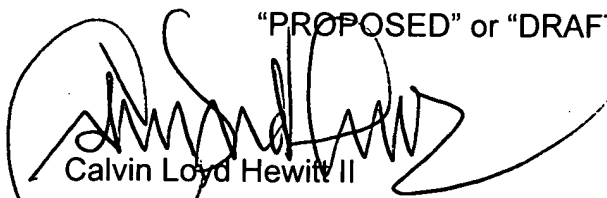
or faxed to:

        (703) 305-7687 (for formal communications intended for entry and

        after-final communications),

or:

        (571) 273-6709 (for informal or draft communications, please label

        "PROPOSED" or "DRAFT")

Calvin Loyd Hewitt II

May 9, 2005